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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/272,562	03/19/1999	SHAHRIAR ALAM	MDHS-378A	5836

7590

07/02/2002

ROBERT A WESTERLUND
1820 N HERNDON STREET
ARLINGTON, VA 22201

EXAMINER

GUARRIELLO, JOHN J

ART UNIT

PAPER NUMBER

1771

DATE MAILED: 07/02/2002

15

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-15

Office Action Summary

Application No.

09/272562

Applicant(s)

Alam et al.

Examiner

John Guarnicello

Group Art Unit

1771

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 3/25/2002
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-11, 21-27 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-5, 7-11, 23, 27 is/are rejected.
- ☒ Claim(s) 6, 21, 22, 24-26 is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

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DETAILED ACTION

15. The Examiner acknowledges papers # 13, the extension of time, and paper #14 the response of 3/25/2002.

16. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 102

17. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Kawai et al. 5,403,422.

Rejection is maintained substantially as in paper #12 of 10/24/2001.

Applicant's arguments regarding co-curable have been considered but they are not persuasive because co-curable is not a positive limitation but only requires the ability to so perform not actual co-curing since it is similar to "capable of" language and implication, (paper # 6 of 11/21/2000, paragraph # 20).

Applicant's arguments regarding '422 as non-analogous art have been considered but are not persuasive because non-analogous art argument is not

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applicable to anticipation, it is only relevant to obviousness. Claims lack novelty.

Claim Rejections - 35 USC § 103

18. Claims 3-5, 7-11, 23, 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawai et al. 5,403,422 in view of Whyzmuzis 5,714,526 and Ruffoni 5,185, 381 and Neaves et al. 4,879,148.

Rejection is maintained substantially as in paper # 12 of 10/24/2001. Applicant's arguments regarding co-curable have been considered but they are not persuasive because co-curable is not a positive limitation but just requires the ability, not actual co-curing (paper #6 of 11/21/2000, paragraph # 20), these claims are not method claims. Applicant's arguments regarding resistive and conductive have been considered but they are not persuasive because epoxy resins and melamine are inherent resistive to conduction. Resistive is not conductive. Applicant's argument regarding Ruffoni is noted, see Ruffoni paper # 3 of 8/2/2000, and Ruffoni does describe a foam material impregnated with an ink which includes a resin carrier with conductive and/or

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magnetic material such as silver, copper, and nickel. Regarding applicant's argument of hindsight, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill, see the rest of this paragraph below, at the time the invention was made, and does not include knowledge gleaned only from applicant's disclosure, such a reconstruction is proper, In re McLaughlin, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Regarding applicant's argument of no motivation to combine, the test for combining is what the combination of disclosures as a whole would suggest to one of ordinary skill in the art, In re McLaughlin, 170 USPQ 209 (CCPA 1971). Whyzmuzis describes the pigment material (which can be conductive) with a woven polyester substrate (column 12, lines 1-36), Neaves describes curable resin (epoxy resin), (column 3, lines 62-64), Ruffoni describes the conductive magnetic material in inks (column 2, lines 63-67) , since the curable resin of Neaves and the adhesive resin of Kawai appear to be similar and appear to be

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co-cured (column 5, lines 23-29) they are considered to be compatible (column 5, lines 28-29), i.e. curable resin and the adhesive material may be the same. Since combined references describe the woven polyester substrate (like the fibrous sublayer), an adhesive layer (like the curable resin), ink pattern containing the pigment material which can be conductive, the claimed invention would still be obvious to one of ordinary skill in the art..

19. Claims 6, 21, 22, 24-26 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The prior art of record fails to disclose the stated limitations of the above claims relating to thickness, thermosetting resin, density, and resolution parameters nor any rationale of why these stated limitations would be obvious.

20. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first

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reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John J. Guarriello whose telephone number is 703-308-3209. The examiner can normally be reached on Monday to Friday from 8 am to 4 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on (703) 308-2414. The fax phone number for the organization where this application or proceeding is assigned is 703-305-5408.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661 .


John J. Guarriello:gj

Patent Examiner

June 14, 2002

June 17, 2002


TERREL MORRIS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700